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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,448	12/03/2003	Jefferson Craig Lind	988.1045000	6733
7590 Russell D. Culbertson Suite 420 1114 Lost Creek Blvd. Austin, TX 78746			EXAMINER McCULLOCH JR, WILLIAM H	
			ART UNIT 3714	PAPER NUMBER
			MAIL DATE 04/29/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/726,448

Applicant(s)

LIND ET AL.

Examiner

William H. McCulloch

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 20-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 20-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to amendments received 12/26/2007. Claims 1-18 and 20-24 are pending in the application, with claims 1, 9, 18 and 23 currently amended, and claim 24 newly added.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-7, 18, 20-22, and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. 2003/0003980 to Moody (hereinafter Moody).

Regarding claims 1, 18, and 20, Moody teaches a method and program product including the following:

(a) obtaining a game play result (e.g., outcome of the bonus game) for a player in response to a game play request in a game (e.g., player initiates primary game and/or initiation of the bonus game; see at least paragraphs 14-19), the game play result specifying a prize value and being obtained independently of play in a bonus round for the game (e.g., determination of a bonus round outcome is established before the player plays the bonus round, and/or the game play result is the outcome of the bonus game; see at least paragraphs 14-19);

(b) associating the game play result with the bonus round (a determined outcome of the primary game indicates that a bonus round will be performed by the gaming machine, and/or the outcome of the bonus game is clearly associated with the bonus game; see at least paragraphs 17-20);

(c) after the game play request in the game, enabling the player to play the bonus round by presenting the player with a number of selection options from which to choose and enabling the player to make a selection from among the selection options (player makes selections, such as by answering multiple-choice questions, in the bonus game; see at least paragraphs 20-23);

(d) concealing the prize value from the player during the bonus round until the player makes the selection (the player is unaware of the bonus prize amount until making at least one selection; see *Id.*);

(e) in response to the selection, displaying the prize value to the player as a result for play of the bonus round (as before, the player is unaware of the bonus prize amount until making at least one selection; see *Id.*).

Regarding claim 2, Moody teaches a method further including obtaining an additional game play result for the player in response to an additional game play result in the game, the additional game play result comprising a non-bonus round game play result and being associated with a respective prize value, and also including responding to the non-bonus round game play result by displaying to the player the respective prize value associated with the non-bonus round game play result, the non-bonus round

game play result not being associated with the bonus round (Moody teaches such in a subsequent, non-bonus outcome of the primary game; see at least paragraphs 16-17).

Regarding claim 3: In applicant's remarks received by the Office on 5/25/2007, applicant essentially argues that the "bingo card pattern" and "bingo-type game" recitations do not necessarily refer to traditional bingo games wherein a player manually daubs the card in the spaces representing 'called' bingo balls (see pages 12-13). In view of these arguments, the Examiner will interpret the bingo-related recitations of claim 3 as being merely visual in the sense that the game merely looks like a bingo game or had some other characteristic in common with bingo games known in the art. As such, the invention as claimed exhibits a game output to the player that is obtained independently of actual play of the bonus game (see claim 1), and that appears to the player to be similar to a bingo game. In actuality, the player has not played a game of bingo, as it is known in the art, but rather the player has made a selection and in response, the game device outputs a prize value and what appears to the player to be a winning bingo outcome commensurate with the prize value. Therefore, Moody anticipates the recited bingo-type pattern in at least the teaching of a slot machine game outcome, wherein a winning outcome may correspond, for example, to all elements of one diagonal of an N-by-N grid having the same symbol.

Regarding claim 4, Moody further teaches that associating the game play result with the bonus round is performed in response to a random event (e.g. the bonus round is initiated in response to a particular combination of symbols on a play line of a video slot machine; see at least paragraph 17).

Regarding claims 5 and 21, Moody further teaches that associating the game play result with the bonus round is performed in response to a predetermined event, wherein the predetermined event is the player's request for a game play result (see rejection of claim 1). The request to play the game is unrelated to the selection by the gaming machine of game play result.

Regarding claim 6, Moody teaches that the step of associating the game play result with the bonus round is performed according to a predetermined relationship between the game play result and the bonus round (similar to the explanation of claim 4, Moody teaches that the association of the game play result with the bonus round is performed according to a relationship between the symbols on a payline and the predetermined set of primary game outcomes that yield a bonus round.)

Regarding claims 7 and 22, Moody teaches the limitations of the claim by displaying the graphical depictions associated with the selection bonus game, as described above.

Regarding claim 24, Moody teaches performing a table look up to identify the prize value specified by the game play result at least because the game device (i.e., computer controls) randomly selects an award from a pool of possible awards (see at least paragraph 19). The pool of possible awards corresponds to the claimed "table" because they are both logical collections of numbers. Selection of one award from the collection of awards is interpreted as performing a "look up".

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 8 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moody in view of Admitted Prior Art.

Claims 8 and 23 are directed toward a bonus game wherein a player is presented with a number of selection options from which to choose and is a graphical depiction of a number of participants in a contest. Moody teaches the invention substantially as described above but lacks in explicitly teaching that players may choose participants of a contest. As was detailed in the previous rejections, it was notoriously well known in the art to offer bonus games wherein a player may select one or more racers, for instance horses in a race, on which to place bets and possibly win bonus prizes. Applicant has not seasonably challenged the Examiner's assertion that it was known in the art at the time of invention to offer such games wherein the player selects objects representative of participants in a contest, and as such that assertion is admitted prior art. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the device of Moody in order to allow players to play a game having a graphical depiction of a number of objects representing respective participants in a contest in order to provide electronic representations of real life events.

6. Claims 9-15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moody in view of Admitted Prior Art.

Regarding claims 9 and 13, Moody teaches the invention substantially as described above with regard to claims 1-7, 18, and 20-22, but lacks in explicitly teaching a game server operable to obtain a game play result for the game play request. In a previous Office Action, the Examiner took Official Notice that it was known at the time of invention to control a plurality of gaming machines with a centralized server system. Applicant has not adequately challenged the Examiner's Official Notice and it is therefore considered admitted prior art. It would have been an obvious to one of ordinary skill in the art at the time of invention to employ a game server in order control a plurality of gaming machines from centralized server system, in order to provide added consistency and security, among other administrative advantages, to the gaming system.

Regarding claims 10 and 14, Moody teaches a bonus association controller (computer controls of the electronic gaming machine; see at least paragraph 14).

Features of claim 11 are shown in the rejection of claim 4 above. Features of claim 12 are shown in the rejection of claim 5 above. Features of claim 15 are shown in the rejection of claim 7 above. Features of claim 17 are shown in the rejection of claim 2 above.

7. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moody in view of Admitted Prior Art applied to claim 9 above, in view of Admitted Prior Art applied to claims 8 and 23 above.

The invention taught by Moody in view of Official Notice is described above in relation to claim 9, but lacks in explicitly teaching that players may choose participants of a contest. It would have been obvious to modify the invention taught by Moody in view of Admitted Prior Art for the same reasons set forth above with regard to claims 8 and 23.

Response to Arguments

8. Applicant's arguments filed 12/27/2007 have been fully considered but they are not persuasive.

On pages 9-10 of the response, Applicant appears to correctly characterize the Moody reference's teachings, but does not appear to understand the interpretation applied to the claimed invention. First, Applicant equates the claimed "game play result" as the outcome of the base game; however, in at least claim 1, there is no indication of such. As a result of the current amendment, the "game play result" in claim 1 is interpreted as the outcome of the bonus game, at least because the game play result is "associated" with the bonus round, and because the game play result specifies (e.g., specifies to the player) a prize value.

Applicant appears to have considered this interpretation due to the fact that Applicant states that "the randomly selected secondary event game award described at paragraph 0019 of Moody cannot be considered the 'game play result' required in the present claims because the randomly selected secondary event game award is not obtained in response to a game play request" (Remarks, page 10, lines 17-19). The Examiner submits that Moody's secondary game award is randomly selected in

response to a game play request for at least two reasons. First, the claims do not specify who or what is making the game play request, despite Applicant's assertion that the request is "the player's game play request" (Remarks, page 10, line 8). In fact, the claimed invention merely says "a game play request" that is generic, not specific to a game player's game play request. Second, even if the request were to be interpreted as a player's request, the secondary game outcome of Moody could not possibly be obtained without a player's request to begin the game, for example by entering coins or credits and activating the base game. As such, the request to play the bonus game is *in response to* the player's request to play the game in the first place. Therefore, Applicant's line of reasoning is unpersuasive.

On page 11 of the remarks, Applicant addresses the feature of claim 3 relating to "bingo-type" games, indicating that the previous Office Action asserted that the bingo-type game is not a bingo game. The Examiner wishes to further clarify the issue. As explained above, the Examiner interprets "bingo-type" games as games that have some, but not necessarily all, elements in common with a known prior art bingo game. If Applicant had intended to claim limitations of the game of Bingo, presumably the claims would simply recite "bingo" rather than "bingo-type". Following this line of reasoning, the Examiner interprets a slot machine game taught by Moody as being a "bingo-type" game because a slot machine is similar to bingo in the appearance of the outcomes. Specifically, in a slot machine game the player wins by aligning symbols on a pay line. Similarly, a player of a bingo game wins by aligning daubed spots on a "pay

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line", wherein the "pay line" of a bingo game is typically five elements in a row in any direction (e.g., vertically, horizontally, diagonally, etc.)

Section III of the Remarks is directed in part toward arguments that because the independent claims are patentable over the prior art, the dependent claims must be patentable for the same reasons. The Examiner has demonstrated above that Moody anticipates the independent claims and thus Applicant's argument is unpersuasive.

Section III additionally addresses the rejection of claims over Moody in view of Official Notice and Admitted Prior Art, wherein the Applicant argues that no admissions of prior art have been made. The Examiner respectfully disagrees. Section 2144.03 of the MPEP clearly states *inter alia* the following about reliance on common knowledge in the art or well known prior art:

Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)). In *Ahlert*, the court held that the Board properly took judicial notice that "it is old to adjust intensity of a flame in accordance with the heat requirement." See also *In re Fox*, 471 F.2d 1405, 1407, 176 USPQ 340, 341 (CCPA 1973) (the court took "judicial notice of the fact that tape recorders commonly erase tape automatically when new 'audio information' is recorded on a tape which already has a recording on it"). In appropriate circumstances, it might not be unreasonable to take official notice of the fact that it is desirable to make something faster, cheaper, better, or stronger without the specific support of documentary evidence. Furthermore, it might not be unreasonable for the examiner in a first Office action to take official notice of facts by asserting that certain limitations in a dependent claim are old and well known expedients in the art without the support of documentary evidence provided the facts so noticed are of notorious character and serve only to "fill in the gaps" which might exist in the evidentiary showing made by the examiner to support a particular

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ground of rejection. *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001); *Ahlert*, 424 F.2d at 1092, 165 USPQ at 421.

The Examiner submits that this and previous Official Actions correctly followed the above procedure for relying upon well-known facts. The MPEP goes on to show the procedure for Applicant to traverse:

To adequately traverse such a finding [by the examiner], an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR **1.111(b)**. See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241 ("[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention."). A general allegation that the claims define a patentable invention without any reference to the examiner's assertion of official notice would be inadequate. If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR **1.104(c)(2)**. See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 ("[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR **1.104(d)(2)**.

Finally, the MPEP states the procedure the Examiner is to take in an Official Action subsequent to relying upon well-known facts:

If applicant does not traverse the examiner's assertion of official notice or applicant's traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. If the traverse was inadequate, the examiner should include an explanation as to why it was inadequate.

Considering the above guidance from the MPEP, the Examiner submits that facts which were previously noted as Admitted Prior Art (those relating to claims 8, 16, and 23) are properly considered to be admitted prior art.

On page 12, lines 6-7, Applicant asserts that the previous Office Action fails to show any reason in the prior art for making the proposed modification of Moody as to the requirements of the claims. The Examiner respectfully disagrees. The Office Action specifically stated, "[I]t would have been obvious to one of ordinary skill in the art at the time of invention to modify the device of Moody in order to allow players to play a game having a graphical depiction of a number of objects representing respective participants in a contest" (page 6 of Office Action mailed 7/23/07). Clearly, because such games having graphical representations of participants in a contest are so well known (such as simulated sporting events, horse races, etc.), the advantageous aspect is the electronic representation of real life events upon which wagers are known to be placed. This is the same reason that video poker looks like real poker (using actual cards): it provides an electronic simulation of a real life event.

Page 12, line 18 through page 13, line 2 addresses the most recent Official Notice (which is now admitted prior art) regarding claims 9-15 and 17. As with previous responses by Applicant, there is simply no challenge to the Examiner's Official Notice. The second MPEP cite above clearly states, "A general allegation that the claims define a patentable invention without any reference to the examiner's assertion of official notice would be inadequate." Such is the case regarding claims 9-15 and 17: Applicant fails to specifically point out the supposed errors in the examiner's action, which would include

stating why the noticed facts are not considered to be common knowledge or well-known in the art. Therefore, the Examiner has correctly asserted that controlling a plurality of gaming machines with a centralized server system was notoriously well known in the art at the time of invention, and it is now considered admitted prior art.

Finally, it should be noted that prior art examples for which Official Notice was taken have already been supplied by the Examiner, even though they were not required, in the Office Action mailed 1/25/07. Specifically, U.S. 6,210,275 to Olsen teaches of graphical depictions of participants in a contest and U.S. 6,015,344 to Kelly et al. teaches of a server controlling multiple gaming machines.

For the reasons given herein, the claimed invention fails to show patentability over the prior art.

Citation of Pertinent Prior Art

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. 5,935,002 to Falciglia teaches a computer-based system and method for playing a bingo-like game.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. McCulloch whose telephone number is (571) 272-2818. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/W. H. M./
Examiner, Art Unit 3714
4/18/2008

/Robert E Pezzuto/
Supervisory Patent Examiner, Art Unit 3714